REMARKS

This Amendment is in reply to the Official Action mailed November 29, 2004. Claims 1

through 10 are now pending and claims 1 and 3 have been amended.

Rejection of Claims Under 35 U.S.C. § 112, Paragraph 2

Claims 1-10 stand rejected under 35 U.S.C. § 112, Paragraph 2. Section 112 does not

require that steps in a method claim recite with who or what is performing a step or the order of the

steps, only that the claim otherwise be definite. To expedite prosecution, Applicant has made

amendments to clarify concerns raised by the Patent Office as to the definiteness of claim 1. The

amendments make express that the carrier performs several of the recited steps and that a scanner is

used to automatically register the parcel in the secure receptacle by communicating the placement of

the parcel over a communication link. Claim 1 has also been amended to recite more particularly

the order of the recited steps.

For completeness, Applicant notes that claim 3 includes a conforming amendment because

claim 1 provides antecedence for "the communication link," and also has been amended to omit the

"contemporaneously with" recitation.

In view of the amendments to claim 1, withdrawal of the Section 112 rejection is requested.

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Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 1-4 and 6-9 were rejected by the Patent Office as being unpatentable under 35

U.S.C. § 103(a) for obviousness over Sosan (US 5,624,071) in further view of Ogilvie et al. (US

6,344,796). Claims 5 and 10 were rejected by the Patent Office as being unpatentable under 35

U.S.C. § 103(a) for obviousness over Sosan in view of Ogilvie and in further view of Nishiyama et

al (US 3,689,155).

The Patent Office acknowledges that Sosan "does not specifically disclose automatically

registering the placement of the parcel within the secure receptacle after the securing step" (claim 1,

step (f)) and does not specifically disclose "wherein the registering step is in response to and

contemporaneously with the securing step," but contends that Sosan discloses "using a bar code

scanner to decode a combination and use this combination to deliver a package." For the features

missing in Sosan, the Patent Office cites to Ogilvie and states that the motivation for modifying

Sosan is to keep a record of the package that was delivered.

Response to § 103(a) Rejection of Claims

The Patent Office contends that step (f), the automatic parcel registration within the secure

receptacle, is not "specifically" disclosed in Sosan. In fact, Sosan does not hint or suggest at such a

step. The bar code of Sosan to which the Patent Office refers is to decode information that is used

to deliver a package, and not for automatically registering the delivery of a package into a secure

receptacle "by communicating placement data concerning the placement of the parcel within the

secure receptacle over a communication link." Sosan's teachings are insufficient to disclose or

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suggest the method of claim 1. Sosan teaches only that a locked box can be opened by the postal

carrier using a code on the package and by the intended recipient using the same code.

The method of claim 1 is an improvement in the art and is not suggested by Sosan. The

Patent Office recognizes the deficiency in Sosan and cites to Ogilvie for the missing features;

however, Ogilvie is not available as a reference, as explained below, and so the rejection over Sosan

in view of Ogilvie should be withdrawn and the claims allowed.

In the accompanying Declaration of Clifton C. Thompson, the inventor establishes prior

invention to Ogilvie and includes Exhibits with facts to establish a conception of the claimed

invention prior to the earliest effective date of the Ogilvie patent and due diligence from prior to the

effective date of Ogilvie to the filing of the subject application. Ogilvie claims a cross-docking

apparatus and method that utilizes a cross-docking apparatus. The cross-docking apparatus is an

intermediate destination for a parcel rather than a secure receptacle at the address of the intended

recipient on the delivery instructions. Because Ogilvie does not claim the same patentable invention

as in the subject application, a Rule 1.131 Declaration is appropriate.

Accordingly, Ogilvie is not available as a reference against the pending claims and the

rejection in view of Ogilvie cannot stand. Reconsideration and withdrawal of the Section 103(a)

rejections are requested.

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The Examiner is invited to contact the undersigned if he perceives of a basis for resolving any outstanding issues.

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Respectfully submitted,

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